



Docket No.: 8147.002.00-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Namsuk KIM

Customer No.: 30827

Application No.: 10/003,429

Confirmation No.: 5412

Filed: December 6, 2001

Art Unit: 3621

For: ELECTRONIC IDENTIFICATION SYSTEM

Examiner: Salvatore A. Cangialosi

REQUEST FOR RECONSIDERATION

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated August 17, 2004, wherein pending claims 1-10 are rejected, Applicant respectfully requests favorable reconsideration in view of the remarks presented herein below.

In paragraph 2 of the Office Action, the Examiner rejects claims 1-10 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent No. 5,903,880 to Biffar ("Biffar") in view of U.S. Patent No. 5,590,197 to Chen et al. ("Chen") or U.S. Patent No. 4,802,218 to Wright et al. ("Wright"). Applicant respectfully traverses this rejection.

In order to support a rejection under 35 U.S.C. §103, the Office Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some motivation or suggestion to combine/modify the applied references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-10 are not

properly rejected under 35 U.S.C. §103 because the Office Action fails to establish a *prima facie* case of obviousness as discussed below.

The first criteria required to establish obviousness is that there must be some motivation or suggestion to combine/modify the applied references. Furthermore, the mere fact that references can be combined is not in and of itself sufficient to establish the resultant combination obvious. As stated in section 2143.01 of the MPEP, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

In rejecting claims 1-10, the Examiner asserts that it would have been obvious to one skilled in the art to modify the teaching of Biffar to include authentication between plural parties in electronic commerce transactions including clients, merchants, and external verifiers because authorization and authentication are conventionally functional equivalents. This assertion is unfounded for the following reasons.

First, it appears that the Examiner is asserting that one skilled in the art would have been motivated to modify the authorization system of Biffar to include authentication between plural parties as allegedly disclosed in both Chen and Wright to achieve the functional equivalent of authorization. However, it is unclear how the Examiner, absent hindsight, can assert that one skilled in the art would be motivated to modify a system to achieve the functional equivalent of the system without modification.

Second, it is unclear how the digital voucher system of Biffar could be modified to include the cyber wallet system of Chen or the automated transaction system of Wright, both of which utilize the use of a card, such as a smart card, instead of a circulating digital voucher as disclosed by Biffar.

Accordingly, absent proper motivation to combine the teachings of Biffar with Chen or Wright, the rejection of claims 1-10 under 35 U.S.C. §103 in view of the combinations thereof is improper.

The third criteria required to establish a *prima facie* case of obviousness is that the combination must teach each and every claimed element. In the present case, claims 1-10 are not rendered unpatentable over the combination of Biffar and Chen or Biffar and Wright for at least the reason that each of these combinations fails to disclose each and every claimed element as discussed below.

Independent claim 1 defines a method of authenticating in a network-based transaction. The method includes, *inter alia*, receiving a transaction request from a first party; requesting client identification by a second party; receiving a first authorization code of the first party for authentication by the second party; submitting a second authorization code of the second party and the first authorization code of the first party to an electronic identification system for verifying the first and second authorization codes; and sending specific information of the first party to the second party via an electronic form of the second party.

In rejecting claim 1, the Examiner asserts that Biffar discloses a method for authenticating a network transaction employing authorization codes substantially as claimed, with the exception being the specific network parties, users, clients and merchants. This assertion is unfounded for the following reason.

Biffar discloses a self-contained payment system which utilizes circulating digital vouchers for the transfer of value. Nowhere in Biffar is there any disclosure or suggestion of an authenticating method as claimed. More specifically, nowhere in Biffar is there any disclosure or suggestion of requesting client identification by a second party; receiving a first authorization code of the first party for authentication by the second party; submitting a second authorization

code of the second party and the first authorization code of the first party to an electronic identification system for verifying the first and second authorization codes; and sending specific information of the first party to the second party via an electronic form of the second party. Furthermore, neither Chen nor Wright disclose or suggest an authenticating method as claimed.

Since Biffar, Chen, and Wright each fail to disclose or suggest an authentication method that includes requesting client identification by a second party; receiving a first authorization code of the first party for authentication by the second party; submitting a second authorization code of the second party and the first authorization code of the first party to an electronic identification system for verifying the first and second authorization codes; and sending specific information of the first party to the second party via an electronic form of the second party, any combination of these three documents cannot possibly disclosure or suggest said steps. Therefore, even if one skilled in the art were motivated to combine Biffar and Chen or Biffar and Wright as suggested by the Office Action, either combination would still fail to render claim 1 unpatentable for at least the reason that both combinations fail to disclose each and every claimed step.

Independent claim 10 defines an authentication method that includes, *intra alia*, all of the steps recited in claim 1. Furthermore, claims 2-9 depend from independent claim 1. Therefore, claims 2-10 are patentably distinguishable over the combination of Biffar and Chen or Biffar and Wright for at least those reasons presented above with respect to claim 1. Accordingly, Applicant request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. §103.

Finally, Applicant notes that although the Examiner asserts that Biffar discloses a method substantially as recited in claims 1-10, the Examiner fails to provide any reference as to where in the disclosure of Biffar the claimed steps are taught. Accordingly, should this rejection be

maintained in a future Action, Applicant request that the Examiner point out by column and line number where the claimed steps are taught such that Applicant will have sufficient information with which to respond.

The application is in condition for allowance. Notice of same is earnestly solicited. Should the Examiner find for any reason that the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: February 17, 2005

Respectfully submitted,

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